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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210390
Party	Plaintiff Feel the World, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

FEEL THE WORLD, INC.  Opposer,  v.  HEAPSYLON, LLC  Applicant.	Opposition No. 91210390 Serial No. 85778259
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**OPPOSER’S RESPONSE TO APPLICANT’S MOTION TO DISMISS AMENDED  
PLEADING**

Opposer, Feel the World, Inc. (“Opposer”), through its attorney Philip A. Matthews, hereby responds to Heapsylon, LLC’s (“Applicant”) Motion to Dismiss Amended Pleading. Counsel for Opposer notes that the paragraphs of the Amended Complaint are numbered as follows: 1, 2, 3, 2, 3, 4. Counsel for Opposer for purposes of this Response will reference the repeated paragraph number 2 as 2(4), repeated paragraph number 3 as 3(5) and the listed paragraph number 4 as 4(6).

**1. Opposer has standing and valid grounds exist for opposing Applicant’s mark**

Section 309.03(b) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) section 309.03(b) states “Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint. [Note 1.] *See TBMP § 303*. At the pleading stage, all that is required is that a plaintiff allege fact sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered.... To plead a “real interest.” Plaintiff must allege a “direct and

personal stake” in the outcome of the proceeding. [Note 3.] The allegation in support of plaintiff’s belief of damage must have a reasonable basis “in fact.” [Note 4.]

Paragraphs 3 and 4(6) of the Amended Complaint state the reasoning for standing. On 10 March 2013, The United States Patent and Trademark Office issued an Office Action related to Opposer’s trademark application (Serial No. 85779750) that said, in part, if Applicant’s mark (Serial No. 85778259) registers, because the filing date of the application precedes Opposer’s application (Serial No. 85779750), Opposer’s mark may be refused registration because of the likelihood of confusion with Applicant’s mark. Opposer will be damaged and has a real interest in this proceeding, because if Applicant’s mark registers it will preclude Opposer’s mark from achieving registration.

TMEP §906 states “...The federal registration symbol may not be used with marks that are not actually registered in the United States Patent and Trademark Office. Even if an application is pending, the registration symbol may not be used until the mark is registered.”

TMEP §906.02 states “Improper use of the federal registration symbol that is deliberate and intended to deceive or mislead the public is fraud.” *See also* TMEP §906.04 and 15 U.S.C. § 1111. In Paragraphs 3, 2(4), 3(5), and 4(6) of the Amended Complaint, Opposer cites to the referenced rules above and explains details regarding the fraud committed by the Applicant on the USPTO. Opposer cited a valid ground for opposing Applicant’s mark.

## **2. Priority not required for fraud**

Applicant provides no basis for their priority argument. There is no mention or indication of a priority requirement to oppose a mark for fraud under TMEP §906, TMEP §906.02, TMEP §906.04 and 15 U.S.C. § 1111.

### **3. Fraud plead with specificity**

To claim fraud on the USPTO the Opposer must allege that the Applicant obtained its registration fraudulently by knowingly making a false, material representation of fact with the intent to deceive the United States Patent and Trademark Office. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Further, allegations of fraud must be set forth with particularity, although malice, intent, knowledge, and other conditions of a person's mind may be averred generally. See Fed. R. Civ. P. 9(b); Trademark Rule 2.116(a). See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”); and 5A Fed. Prac. & Proc. Civ.3d § 1298 (April 2013) (discussing particularity requirement of Fed. R. Civ. P. 9(b)).

Applicant argues that the use of “On information and belief” is improper. There is no use of “On information and belief” in the Amended Complaint. Statements of fact regarding Applicant's fraud on the USPTO are found in the Attachments to the Amended Complaint and in paragraphs 2(4) and 3(5).

The Opposer states in paragraphs 2(4) and 3(5) of the Amended Complaint who committed the fraud and the actions committed by Applicant which constitute fraud on the USPTO, and cited specific rules the Applicant violated (TMEP §906, TMEP §906.02, TMEP §906.04 and 15 U.S.C. § 1111).

The Applicant misinterprets the intent requirement as it relates to fraud on the USPTO. As stated above, allegations of fraud must be set forth with particularity, although malice, intent, knowledge, and other conditions of a person's mind may be averred generally. See Fed. R. Civ. P. 9(b); Trademark Rule 2.116(a). See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*,

667 F.2d 1008, 212 USPQ 801 (CCPA 1981). Here, pleading intent is averred, even though detailed by the Opposer through the evidence of fraud provided in paragraphs 2(4) and 4(5) and Attachments of the Amended Complaint.

#### **4. Rule for sustaining the Opposition cited**

In Paragraphs 2(4), 3(5), and 4(6) of the Amended complaint Opposer cites TMEP §906, TMEP §906.02, TMEP §906.04 and 15 U.S.C. § 1111. These rules pertain directly to the alleged cause of action and sustain the Opposition.

#### **5. Fraud cannot be moot**

Fraud is an irreparable action which cannot be rendered moot. Claiming that fraud on the USPTO is moot is like claiming a theft did not occur after the thief returned the stolen item.

The cases cited by the Applicant are not relevant to fraud on the USPTO and should not be considered. The cause of action in the *Irish Lesbian & Gay Org. v. Giuliani* case determined whether an appeal to determine whether a judgment to deny a preliminary injunction and dismiss all remaining claims before discovery or a trial on the merits can have preclusive effect if a party attempts to raise the same claim against the same parties one year later. The *ABC, Inc. v. Stewart* case dealt with issues surrounding the 1<sup>st</sup> Amendment rights of the press and the 6<sup>th</sup> Amendment right to criminal defendants. Additionally, the text quoted by the Applicant from *ABC, Inc. v. Stewart* only contemplates acts which occur “while a case is pending on appeal”. The act of fraud on the USPTO by the Applicant occurred prior to the filing of this Opposition proceeding.

The Applicant’s arguments claiming their fraud is moot should be ignored.

#### **6. Conclusion**

Opposer’s Amended Complaint complies with all requirements for standing and appropriately claims that Applicant committed fraud on the USPTO. For the foregoing reasons,

Opposer respectfully requests the Board deny Applicant's Motion to Dismiss the Amended Pleading.

Respectfully submitted,

Date: 10/7/2013

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS AMENDED PLEADING** has this 7th day of October, 2013 been mailed by prepaid first class mail to Anthony M. Verna, attorney for Heapsylon, LLC, Applicant, to: Kravitz & Verna LLC, PO Box 3620293, PACC, New York, NY 10129, and via email to: averna@kravitzverna.com.

Date: 10/7/2013

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